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10/577,530	04/28/2006	Tetsuya Nakayama	062394	9834
38834 7590 10/14/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
JEANTY, ROMAIN				
ART UNIT		PAPER NUMBER		
3624				
NOTIFICATION DATE		DELIVERY MODE		
10/14/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

# Office Action Summary

**Application No.**

10/577,530

**Applicant(s)**

NAKAYAMA ET AL.

**Examiner**

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-4 in the reply filed on XXX is acknowledged. Claims 1-4 are pending in the application and are examined below.

### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus

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that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al (US 6,954,689) in view of Bernold (WO0052627).

Regarding claim 1, Hanson et al disclose a system for monitoring vehicles. In so doing, Hanson et al disclose a working machine (i.e., a working vehicle; col. 1, lines 62-63); and a server being capable of communication via a wireless communication network with the working machine (i.e., communicating wirelessly with the working vehicle to a central data center; col. 2, lines 1-12), and also

capable of communication with a plurality of user terminals, the working machine comprising identification information input means which inputs user identification information of one user who is using the working machine at the present time (i.e. receiving input information from a user of the working vehicle; col. 2, lines 13-21); machine information generation means which receives a signal from a predetermined sensor within the working machine and generates machine information related to a state or to an operation of the working machine (col. 3, lines 3-22); and a communication device which can perform communication with the server via the wireless communication network, and which transmits to the server the user identification information which has been inputted by the identification information input means and the machine information which has been generated by the machine information generation means, the server comprising storage means which stores information (col. 2, lines 13-21; col. 3 line 64 through col. 4 line 28); communication control means which can perform communication with the working machine via the wireless communication network, which also can perform communication with the plurality of user terminals, and which receives the user identification information and the machine information from the working machine and transmits a warning to the plurality of user terminals (col. 3 line 64 through col. 4 line 28); usage state decision means which detects by which user usage of the working machine which constitutes a problem is performed, based on the user identification information and the machine information received by the communication control means (col. 4, lines 4-36). Hanson et al disclose all of the limitations above but fails to explicitly

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disclose a warning generation means which generates the warning in response to the usage state decision means, and makes the communication device transmit the warning to the plurality of user terminals. Bernold in the same field of endeavor discloses a crane monitoring and data retrieval system which generates and communicate an alarm event to a user interface device. Not pages 31-32 of Bernold. It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Hanson et al to include the teachings of Bernold in order to detect occurrence of hazardous dragging and extrication events of the working vehicle.

Regarding 2, the combination of Hanson et al and Bernold teaches wherein the working machine comprises a working time sensor, the machine information includes working time information showing a working time which has been detected by the working time sensor. Note rejection of claim 1 above. However the combination of Hanson et al and Bernold fails to detach a usage state decision means comprises reservation information reception means which receives reservation information showing a scheduled time for use of the working machine from each user terminal and the user identification information of the one user who has made a reservation, and which stores the received reservation information in association with the user identification information in the storage means; machine information reception means which, based on the user identification information and the working time information included in the machine information received by the communication control means, generates actual usage information which shows time and data of an actual usage of the

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working machine due to each user, and stores the actual usage information in association with the user identification information in the storage means; and information comparison means which, by comparing the reservation information associated with the user identification information stored in the storage means with the actual usage information, detects, as an usage which constitutes a problem, an actual usage due to a user for which, in the user or the usage time, a substantial difference from the reservation information exists. However, Official Notice is taken that scheduling equipments based on user usage of the equipment and the user identification is old and well known in the art in order to automatically scheduling maintenance sessions based upon usage data, and modifying set schedules based upon changing usage data. It would have been obvious to a person of ordinary skill in the art to have modified the teachings of Hanson et al and Bernold in order to automatically scheduling maintenance sessions based upon usage data of a working equipment.

Regarding claim 3, the combination of Hanson et al and Bernold teaches wherein the working machine comprises a position measurement sensor, the machine information includes position information showing a position which has been detected by the position measurement sensor, and the usage state decision means comprises. Note rejection of claim 1 above. However the combination of Hanson et al and Bernold fails to explicitly disclose reservation information reception means which receives reservation information showing a scheduled place for use of the working machine from each user terminal and the user identification information of the one user who has made a reservation, and

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which stores the received reservation information in association with the user identification information in the storage means; machine information reception means which, based on the user identification information and the position information included in the machine information received by the communication control means, generates actual usage information which shows the actual usage place of the working machine due to each user, and stores an actual usage information in association with the user identification information for each user in the storage means; and information comparison means which, by comparing the reservation information in association with the user identification information stored in the storage means with the actual usage information, detects, as an usage which constitutes a problem, an actual usage due to a user for which, in the usage place, a substantial difference from the reservation information exists. However, Official Notice is taken that scheduling equipments based on user usage of the equipment and the user identification is old and well known in the art in order to automatically scheduling maintenance sessions based upon usage data, and modifying set schedules based upon changing usage data. It would have been obvious to a person of ordinary skill in the art to have modified the teachings of Hanson et al and Bernold in order to automatically scheduling maintenance sessions based upon usage data of a working equipment.

Regarding claim 4, the combination of Hanson et al and Bernold fails to teach wherein the working machine comprises an engine cooling water temperature sensor, the machine information includes water temperature



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information showing an engine cooling water temperature which has been detected by the engine cooling water temperature sensor, and the usage state decision means comprises: machine information reception means which, based on the user identification information and the water temperature information included in the machine information received by the communication control means, calculates an engine water temperature or a load amount of the working machine which originates in usage due to each user; and information comparison means which, based on the engine water temperature or the load amount, for each user, which has been calculated by the machine information reception means, detects, as an usage which constitutes a problem, an usage imposing an excessive load on the working machine, performed by the user. Official Notice is taken that is most working machine such as construction equipments comprise engine cooling water temperature sensor for calculating the engine temperature and detecting abnormalities in the functioning of the equipments. It would have been obvious to a person of ordinary skill in the art to have modified the disclosures of Hanson et al and Bernold in order to detect abnormalities in the functioning of the equipment.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Breunissen et al (US 6,912,481) disclose a technique for scheduling planned maintenance of equipment.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Romain Jeanty/  
Primary Examiner  
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August 30, 2009